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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/956,888	09/21/2001	Sachiko Tajima	211653US0	2424

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/956,888

Applicant(s)

TAJIMA ET AL.

Examiner

Sharmila S. Gollamudi

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1616

DETAILED ACTION

Receipt of Amendments and Arguments filed September 23, 2004 is acknowledged. Claims 1, 3, 6, and 13-16 are pending in this application. Claims 5, 17, 19, and 20 stand cancelled. Claim 21 stands withdrawn as being directed to a non-elected invention.

Election/Restrictions

Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Invention I (claims 1, 3, 6, and 13-16) and Invention II (claim 21) are unrelated.

Invention I is drawn to a product, i.e. a hair formulation whereas invention is drawn to a method of improving odor.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 8 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

The objection to new matter in the specification under 35 U.S.C. 132 is withdrawn in view of the cancellation of the new matter filed on 3/19/04.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1616

Claims 1, 3, 6, and 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has amended the independent claim to recite “up to 3% monoethanolamine”; however applicant does not have support for such a range. Applicant has cited the text of page 4 for support. A careful review of page 4 lends support for a range of 0-3% for *ammonia* but not monoethanolamine.

If applicant contends there is support for such an amendment, then the applicant is requested to cite the specific page and line in the instant specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2033939 in view of XP-002226338 in further view of Mussinan et al (4,335,002).

GB teaches a low ammonia bleach composition. Examples 1 discloses a composition containing 2-20% of an ammonium or alkali earth metal persulfate, perborate, percarbonate, carbonate, 1.5 -7% of hydrogen peroxide, monoethanolamine, a buffer, and water. Note example 1-3. Example 1 discloses the use of 0.12% monoethanolamine and 2.80% in example 3. The reference discloses that the composition produces trace amounts of ammonia gas. See page 3, lines 37-45. Additives such as perfume and essential oils up to 20% is taught on page 3, lines 114-117 and examples. The composition is maintained at a pH of 9-12. See abstract,

The reference does not specify the perfume utilized or the amount of cis-3-hexenol.

XP teaches a perfume composition that deodorizes ammonia odor produced by components contained in cosmetics. The perfume composition contains one or more of cis-3-hexenol, geraniol, linalool, terpineol, etc.

Mussinan et al teach cis-hexenol and its derivatives for a variety of uses such as flavoring, perfumed articles, and cosmetics. The cosmetics that are mentioned are soaps, colognes, hair preparations, and lotions. Cis-hexenol provides a green leafy aroma. See column 1, lines 44-58. The cis-hexenyl derivatives may be utilized as little as 0.5% or up to 50% depending on an array of factors such as the consideration of cost, nature of the end product, the effect desired on the finished end product, and particular fragrance sought. For olfactory components in cosmetics, one or more cis-3-hexenyl derivatives may be used to impart a green, leafy, fruity note and may be used in an amount as little as 0.01% to 0.5%. See column 11, lines 44-67. Example 2 teaches a composition containing instant 26.1% cis-3-hexenol, 33.1% cis-3-

Art Unit: 1616

hexenal, 20.8% trans-2-hexenal, 12.7% cis-3-hexenyl formate, and 2.7% cis-3-hexenyl-cis-hexenoate. In example XX a cosmetic powder composition is analyzed containing wherein 0.25% of the perfume composition of example 2 is utilized. Example II perfume composition provides for a powerful green, fruity, spicy aroma with leaf nuances. Examples XXII utilizes the perfume composition in colognes and examples XXIII utilizes it in soap compositions.

Mussinan teaches the use of different concentrations of the cis-3-hexenyl derivatives produce different aromas such as strong leafy aromas, spicy aromas, or jasmine aromas. For instance, example VIII discloses a basic jasmine formulation wherein the composition contains the perfume in example II along with linalool, geraniol, etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of GB and XP and include XP's perfume composition into GB's hair composition. One would have been motivated to do so since XP teaches the perfume containing cis-3-hexenal deodorizes ammonia gas. Moreover, GB teaches the formulation produces an ammonia odor; thus a skilled artisan would reasonably expect the use of XP's perfume would mask the odors produced by GB's composition.

It would have been further obvious to look to the guidance provided by Mussinan et al teach and utilize the instant amount of cis-hexenol in the perfume composition. One would have been motivated to do so since Mussinan teaches the manipulation of the individual cis-hexenyl derivatives and their concentrations in the perfume composition allows for different aromas. Therefore, the concentration of the individual components in the perfume composition depends on the desired effect and aroma of the perfume composition.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. However, the merits of GB and XP will be discussed.

Applicant argues that GB '939 does not teach *cis*-3-hexanol and this is a critical feature of the instant invention. The instant invention masks the odor of monoethanolamine. Applicant argues that the secondary reference '338 only teaches that the fragrances incorporated mask the smell of *ammonia* not monoethanolamine. Applicant argues that the only examples that contain perfume are the one with ammonia and not monoethanolamine.

Applicant's arguments have been fully considered but they are not persuasive. First, the examiner points out that the claims are rejected under *prima facie* and not under anticipation. Therefore, the primary reference neither has to exemplify formulations or teach every element of the instant invention, or the reference would be said to anticipate the instant invention. The reference merely has to suggest the modification. This is clearly done wherein GB teaches the use of fragrances in the hair composition. It is further pointed out that GB teaches the amount of the fragrance up to 20%. Further, on page 3, GB teaches that the a cosmetic formulation without that much ammonia gas is pleasing and therefore endeavors to reduce the unpleasing smell. The only teaching that is lacking is that of the instant fragrance: *cis*-3-hexanol. The secondary reference supplies the deficiency. The secondary reference teaches the instant fragrance deodorizes the ammonia odor in cosmetics. Therefore, the motivation to utilize the instant invention is to mask the remaining ammonia gas that is produced in GB's hair formulation. One would expect similar results since GB teaches the suitability of fragrances in the formulation and

Art Unit: 1616

the formulation contains ammonia. Further, both references are in the same field of endeavor, i.e. to reduce the ammonia odor in a hair dye composition.

Second, the examiner points out that the instant claims are product claim, therefore the function of an ingredient, i.e. cis-3-hexanol masks monoethanolamine, in a product claim does not hold patentable weight. Thus, the examiner's reason for combining the references may differ from the applicant but the combination yields the same product as the applicant. The fact that applicant has recognized another advantage; i.e. that cis-3-hexanol *also* masks the odor of monoethanolamine, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The examiner additionally points out that to overcome an obviousness rejection, the applicant must show unexpected results to demonstrate the unobviousness of the rejection. In the instant case, one example of showing unobviousness is that applicant demonstrates that monoethanolamine cannot be masked by other perfumes.

Therefore, for the reasons above, the rejection is maintained.

Claims 1, 3, 6, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al (5,817,155) in view of Fragrance Journal (June 1993) in further view of Mussinan et al (4,335,002).

Yasuda et al teach a hair treatment formulation such as hair dyes, hair bleaches, and permanent wave agents. The instant color developing agents and coupling agents are taught on column 2, line 51 to column 3, line 30. The main agent in the permanent wave formulation is a reducing agent such as thioglycolate. See column 3, lines 44-67. Example 6 discloses a

Art Unit: 1616

formulation containing 1% monoethanolamine, aqueous ammonia, 1% ammonia thioglycolate, 1% paraphenylenediamine, 0.3% metaaminophenol, water, and perfume to an appropriate amount, among other components. It is the examiner's position that the examples relied upon for the rejection fall within the instant pH range since the examples are basic hair formulations.

Yasuda et al do not specify the perfume utilized.

The publication teaches perfumes such as cis-hexenol that mask wave lotions containing ammonium thioglycolates in the base composition. The composition contains 0.1% cis-hexenol applied to a base composition containing ammonium thioglycolate, 1.2% ammonia water, and propylene glycol among other components (Note Table 2 and Table 3).

Mussinán et al teach cis-hexenol and its derivatives for a variety of uses such as flavoring, perfumed articles, and cosmetics. The cosmetics that are mentioned are soaps, colognes, hair preparations, and lotions. Cis-hexenol provides a green leafy aroma. See column 1, lines 44-58. The cis-hexenyl derivatives may be utilized as little as 0.5% or up to 50% depending on an array of factors such as the consideration of cost, nature of the end product, the effect desired on the finished end product, and particular fragrance sought. For olfactory components in cosmetics, one or more cis-3-hexenyl derivatives may be used to impart a green, leafy, fruity note and may be used in an amount as little as 0.01% to 0.5%. See column 11, lines 44-67. Example 2 teaches a composition containing instant 26.1% cis-3-hexenol, 33.1% cis-3-hexenal, 20.8% trans-2-hexenal, 12.7% cis-3-hexenyl formate, and 2.7% cis-3-hexenyl-cis-hexenoate. In example XX a cosmetic powder composition is analyzed containing wherein 0.25% of the perfume composition of example 2 is utilized. Example II perfume composition provides for a powerful green, fruity, spicy aroma with leaf nuances. Examples XXII utilizes the

Art Unit: 1616

perfume composition in colognes and examples XXIII utilizes it in soap compositions.

Mussinán teaches the use of different concentrations of the cis-3-hexenyl derivatives produce different aromas such as strong leafy aromas, spicy aromas, or jasmine aromas. For instance, example VIII discloses a basic jasmine formulation wherein the composition contains the perfume in example II along with linalool, geraniol, etc.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Yasuda et al, Fragrance Journal, and Mussinán et al and include the instant perfume in the instant amount. One would be motivated to do so since the Fragrance Journal teaches cis-hexenol effectively masks base compositions containing ammonia and ammonium thioglycolates. Therefore, since Yasuda et al teach a hair dye formulation containing ammonium thioglycolate, a skilled artisan would reasonably expect cis-hexenol to have similar masking capabilities in Yasuda's composition. Therefore, it is prima facie obvious to cis-hexenol to mask the odors of a hair composition this is a known concept in the art.

It would have been further obvious to look to the guidance provided by Mussinán et al teach and utilize the instant amount of cis-hexenol in the perfume composition. One would have been motivated to do so since Mussinán teaches the manipulation of the individual cis-hexenyl derivatives and their concentrations in the perfume composition allows for different aromas. Therefore, the concentration of the individual components in the perfume composition depends on the desired effect and aroma of the perfume composition.

Response to Arguments

Applicant argues that Yasuda et al do not teach the amount of fragrance in the examples and does not teach the instant cis-3-hexenol. Applicant argues that Yasuda does not teach the use

Art Unit: 1616

of perfume to mask the odor of monoethanolamine. Applicant argues that the secondary reference does not cure this deficiency. Lastly, applicant argues that Mussinan et al is directed to cis-3-hexenal and not cis-3-hexenol. Further, applicant argues that Mussinan does not teach utilization of the cis-hexenyl derivatives in hair formulations.

Applicant's arguments have been fully considered but they are not persuasive. First, the examiner points out that the claims are rejected under *prima facie* and not under anticipation. Therefore, the primary reference neither has to exemplify formulations or teach every element of the instant invention, or the reference would be said to anticipate the instant invention. The reference merely has to suggest the modification. This is clearly done wherein Yasuda teaches the use of fragrances in the hair composition. It is the examiner's position that the concentration of the perfume in the hair composition, is dependent on the desired aroma, and this is a conventional skill in the art. However, for *arguendo* sake, if one were to argue it is not within the skill of an ordinary artisan, Mussinan et al makes up for this deficiency.

Second, the examiner points out that the instant claims are product claim, therefore the function of an ingredient, i.e. cis-3-hexanol masks monoethanolamine, in a product claim does not hold patentable weight. Thus, the examiner's reason for combining the references may differ from the applicant but the combination yields the same product as the applicant. The fact that applicant has recognized another advantage; i.e. that cis-3-hexanol *also* masks the odor of monoethanolamine, which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 1616

The examiner additionally points out that to overcome an obviousness rejection, the applicant must show unexpected results to demonstrate the unobviousness of the rejection. In the instant case, one example of showing unobviousness is that applicant demonstrates that monoethanolamine cannot be masked by other perfumes.

Lastly with regards to Mussinan et al, the examiner points out that Mussinan teaches cis-hexenyl derivatives in *general* and although the preferred teaching is directed other derivatives of cis-3-hexanol, preferred embodiments are not a teaching away from the broader disclosure.

See *In re Susi*.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 6, and 13-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/404083. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter recited in both applications are obvious modifications of each other.

Art Unit: 1616

The instant application recites a hair composition containing 20-50% cis-hexenol and monoethanolamine in an oxidation hair color or hair bleaching formulation. Claims 5-6 recites the amount of cis-hexenol in the amount of 0.1-1% and 0.3-0.8% respectively. Claims 13-15 recite color developing agents and coupling agents.

Co-pending application recites a hair composition containing 0.1-1% perfume, which contains 0.1-50% cis-3-hexenol and 0.1-10% monoethanolamine. Claims 2 and 7 recite the monoethanolamine in a oxidation hair coloring or hair bleaching composition. Claims 3-4 recite the amount of cis-hexenol in the amount to mask the odor of monoethanolamine and provide a desirable fragrance respectively.

The above applications are obvious modifications that contain similar subject matter. The co-pending application claims the generic composition and the instant application claims the species. Therefore, the instant application falls within the scope of the co-pending application and this anticipates co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant argues that once the subject matter of the application has been found to be allowable, the applicant will take appropriate action.

Therefore, the rejection is held in abeyance.

Conclusion

Art Unit: 1616

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

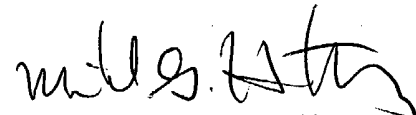
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG


MICHAEL G. HARTLEY
PRIMARY EXAMINER